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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/089,448	07/19/2002	Hiroki Sato	2002-0348A	9408

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EXAMINER

FORD, VANESSA L

ART UNIT PAPER NUMBER

1645

DATE MAILED: 04/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/089,448

Applicant(s)

SATO ET AL.

Examiner

Vanessa L. Ford

Art Unit

1645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 December 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) 1-3 and 5-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 March 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Applicant's amendment and response filed December 27, 2004 are acknowledged. Claim 4 has been amended. The Office apologizes for the error indicating that foreign priority was made. The Office acknowledges that the instant application is a 371 application of PCT/JP99/05317 filed September 29, 1999.

### ***Restriction/Election***

2. Applicant urges that the hypha extract in Mizuno et al differ from that of the instant invention. Applicant urges that the Examiner relies on MPEP 803 to support the restriction requirement. Applicant urges that the restriction is improper and should be withdrawn. Applicant's arguments filed December 27, 2004 have been fully considered but they are not persuasive. Restriction is required under 35 U.S.C. 121 and 372. Group I is directed to an inoculating agent for the production of fruit bodies of an entomopathogenic fungus comprising hyphal bodies of the entomopathogenic fungus. Mizuno teaches an inoculating agent comprising cultured hyphae extract from *Cordyceps sinensis* (an entomopathogenic fungus) (page 259). Group I is the main invention in this application and it lacks novelty, therefore the other claims are not so linked by a special technical feature within the meaning of PCT Rule 13.2 so as to form a single inventive concept. Inasmuch as, the technical feature does not define a contribution over the art, it is not "special" within the meaning of PCT Rule 13.2. Consequently, Groups I, II, III and IV lack unity of invention. To address Applicant's comments regarding MPEP section 803, the Examiner cited this section to point out the

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criteria for patentably distinct inventions. For these reasons the <sup>lack of unity)</sup> restriction requirement <sup>4</sup> is deemed to be proper and is therefore made FINAL.

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in the prior Office Action.

### ***Rejections Withdrawn***

4. In view of Applicant's amendment and Response, the rejections are withdrawn:

- a) rejection of claim 4 under 35 U.S.C. 102(b), page 4, paragraph 2.
- b) rejection of claim 4 under 35 U.S.C. 102(b), page 5, paragraph 3.
- c) rejection of claim 4 under 35 U.S.C. 102(b), page 6, paragraph 4.
- d) rejection of claim 4 under 35 U.S.C. 102(b), page 7, paragraph 5.

### ***New Ground of Rejection***

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claim 4 is rejected under 35 U.S.C. 102(b) as anticipated by Yang et al (*Korean Journal of Mycology*, June 1993, Vol. 21, No.2, p, 94-105).

Claim 4 is drawn to a spawned insect for the production of fruit bodies of an entomopathogenic fungus, being inoculated by injection with hyphal bodies of the entomopathogenic fungus in the body.

Yang et al teach spawned insects (e.g. stinkbugs) that are hosts for the entomopathogenic fungus, *Cordyceps nutans* (page 20). Yang et al teach that fruit bodies were collected from these insects (page 20). Yang et al teach insects in which hyphae were removed (e.g. spawned insects) (page 5). Therefore, the hyphae were present in the insect in order to be removed from the insect. Yang et al teach that two species of insect *Vespa xanthoptera* and *Vespula lewisii* are species of insects in which fruiting bodies of an entomopathogenic fungus can be collected (page 12). Claim limitations “injected by” and “for the production of fruit bodies of an entomopathogenic fungus” are being viewed as a limitation of intended use. It should be noted that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963). Yang et al anticipate the claimed invention.

Since the Office does not have the facilities for examining and comparing applicant's spawned insect with the spawned insect of the prior art, the burden is on the applicant to show a novel or unobvious difference between the claimed product and the product of the prior art (i.e., that the spawned insect of the prior art does not possess the same material structural and functional characteristics of the claimed spawned insect). See In re Best, 562 F.2d 1252, 195 USPQ 430 (CCPA 1977) and In re Fitzgerald et al., 205 USPQ 594.


### **Conclusion**

6. Any inquiry of the general nature or relating to the status of this general application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Papers relating to this application may be submitted to Technology Center 1600, Group 1640 by facsimile transmission. The faxing of such papers must conform with the notice published in the Office Gazette, 1096 OG 30 (November 15, 1989). Should applicant wish to FAX a response, the current FAX number for the Group 1600 is (703) 872-9306.

Any inquiry concerning this communication from the examiner should be directed to Vanessa L. Ford, whose telephone number is (571) 272-0857. The examiner can normally be reached on Monday – Friday from 9:00 AM to 6:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynette Smith, can be reached at (571) 272-0864.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov/>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Vanessa L. Ford  
Biotechnology Patent Examiner  
April 13, 2005

  
LYNETTE R. F. SMITH  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER